



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John G. McBride

Confirmation No.:

Application No.: 09/311,313

Examiner: L. Garbowski

Filing Date: May 13, 1999

Group Art Unit: 2825

Title: Method and Apparatus for Determining Whether an Element in an Integrated Circuit is a Feedback Element

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on Nov. 19, 2002. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Respectfully submitted,

John G. McBride

By Daniel R. McClure

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Date: **Dec. 30, 2002**

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

John G. McBride

Serial No.: 09/311,313

Filed: May 13, 1999

For: Method And Apparatus For
Determining Whether An Element In An
Integrated Circuit Is A Feedback Element

Group Art Unit: 2825

Examiner: Leigh Marie Garbowski

HP Ref. 10971316-1
TKHR Ref. 50814-1550

11/Reply
Brief
1-14-03
A. Welch

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REPLY TO EXAMINER'S ANSWER

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In reply to the Examiner's Answer, Applicant submits the following additional
comments.

On a substantive basis, independent claim 14 (the exemplary claim of the single
claim group) defines over the cited art of record, and the claim calls for the "analyzing
information relating to the network to determine whether or not an *element* comprised in

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examiner WJ
1-22-03

the integrated circuit is a *feedback element, wherein said feedback element includes a transistor.*"

It has become clear that the Applicant and the Examiner disagree on a fundamental point. Specifically, the Examiner's position is that the identification or detection of a feedback loop (which may comprise numerous circuit elements) anticipates the step of determining whether a particular element is a feedback element. To this fundamental point, Applicant strongly disagrees. By way of illustration, in many instances, it is desirable to have a feedback element in circuit designs (e.g., a feedback resistor across the negative input terminal of an operational amplifier). However, in many instances, a feedback element is undesirable. For this, and other reasons, it is desirable to identify particular elements that are feedback elements, as opposed to merely identifying a loop that may be a feedback loop. The independent claims of the present application specifically recite this feature, which is not disclosed in the cited art of record. For this reason alone, the Board should overturn the Examiner's rejection of the independent claims.

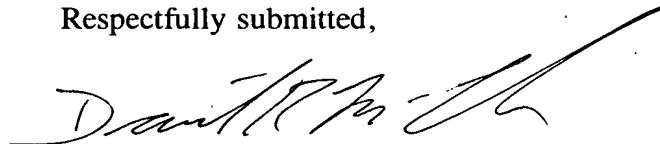
The second point the Applicant wishes to clarify is in response to the Examiner's allegation that the Applicant's brief presented improper arguments relating to the dependent claims, which contained allowable subject matter. In this respect, the Examiner misunderstands the purpose of the Applicant's argument. The argument was used to supplement the main argument as to why the Examiner's interpretation of the independent claims was incorrect. Applicant was not separately arguing the allowability of the dependent claims. Specifically, the Applicant noted that the Examiner had previously indicated that certain claims, which specified that the feedback element to be a field effect transistor, were allowable. In the argument in the Appeal Brief, Applicant was merely pointing out that there is no basis in the current record of the file history to patently distinguish between defining the feedback element to be a field effect transistor and defining

the feedback element to include a transistor. In this regard, the art cited by the Examiner merely discloses the identification of possible feedback loops. Thus, if defining the feedback element to be a field effect transistor is patentable over the cited art (as admitted by the Examiner), then defining the feedback element as including a transistor (as claimed in the independent claims at issue) is also patentable over the cite art.

For at least this additional reason, Applicant submits that the rejection of claim 14 is improper and should be overturned.

No fees are believed to be due in connection with this Reply to Examiner' s Answer. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 08-2025.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel R. McClure", with a long, sweeping horizontal line extending to the right.

Daniel R. McClure
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